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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/062,552	04/20/98	SHIRAIWA	Y 35.G2135

005514 LM31/0328  
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EXAMINER

FIELDS, D

ART UNIT	PAPER NUMBER
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2722

DATE MAILED:

03/28/00

*8*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/062,552

Applicant(s)

Shiraiwa

Examiner

Derrick Fields

Group Art Unit

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☒ Responsive to communication(s) filed on Jan 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-62 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-62 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments filed 1/19/00 have been fully considered but they are not persuasive.

The Applicant argues that Shibaki et al. fails to disclose or suggest a memory medium for storing image data for a plurality of images and image-reproduction instruction data, or image output program, indicating whether or not certain of the image data is to be output for being reproduced. The Examiner respectfully traverse Applicant's arguments. Shibaki et al. disclose **an image storing unit 24** which reads on a memory medium for storing image data for a plurality of images, **a magnetic optical disk storage device 25 for storing (registering) document information and document identification information** which reads on storing image reproduction instruction data (see col. 4, lines 63-67). Also, Shibaki et al. disclose **a function of reading out the stored document information on an as-needed basis and printing the information by means of a printer** (see col. 1, lines 11-13) which reads on an image output program indicating whether or not certain of the image data is to be output for being reproduced.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Previous Office Action.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-55 and 57-62 are rejected under 35 U.S.C. 102(e) as being anticipated by

**Shibaki et al. '368.**

Regarding claims 1, 47, 51, 57, 59, 61, and 62, Shibaki et al. discloses a memory medium for storing image data *comprising* a magnetic optical (MO) disk storage device **25** for storing document information (see col. 4, lines 65-67), image-reproduction instruction data for instructing whether or not the image data is to be reproduced so that the image-reproduction instruction data specifies an image for which image reproduction is instructed *comprising* a function of reading

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out the stored document information on an as-needed basis (see col. 1, lines 11-12), and that the specified image data can be selectively output based on the image reproduction instruction data *comprising* printing out the document information by means of a printer (col. 1, lines 12-13).

Regarding claims 2 and 4, Shibaki et al. discloses wherein memory medium also stores a program for controlling reproduction of the image data based on the image-reproduction instruction data and wherein the image-reproduction instruction data is provided for the name of each image data *comprising* a function of reading out the stored document information on an as-needed basis (see col. 1, lines 11-12).

Regarding claims 3 and 5, Shibaki et al. discloses wherein the image-reproduction instruction data is stored for each image data and wherein the image-reproduction instruction data comprises information for instructing image data to be reproduced stored in a specific file *comprising* printing identification information for specifying the document information stored in the storing medium (see col. 2, lines 22-23).

Regarding claims 6-8 and 39-42, Shibaki et al. disclose an image output control method comprising a function of recognizing mounting of a recording medium comprising a control panel unit for selecting a copy mode or a file mode (see col. 6, lines 57-59).

Regarding claims 9-26, Shibaki et al. disclose wherein said control function has a function of determining whether or not image-reproduction instruction data is stored in the medium, and wherein when it has been determined that image-reproduction instruction data is stored, said control function controls output so as to selectively output image data instructed by the image-

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reproduction instruction data comprising a function of reading out the stored document information on an as-needed basis and printing out the document information by means of a printer (see col. 1, lines 11-13).

Regarding claims 27, 29, 31, 33, 43, 45 and 49, Shibaki et al. disclose wherein a program for controlling reproduction of the image data based on the image-reproduction instruction data and wherein the image-reproduction instruction data is provided for the name of each image data *comprising* a function of reading out the stored document information on an as-needed basis (see col. 1, lines 11-12).

Regarding claims 28, 30, 32, 34, 44, 46, 48, and 50, Shibaki et al. disclose wherein the image-reproduction instruction data is stored for each image data and wherein the image-reproduction instruction data comprises information for instructing image data to be reproduced stored in a specific file *comprising* printing identification information for specifying the document information stored in the storing medium (see col. 2, lines 22-23).

Regarding claims 35 and 36, Shibaki et al. disclose wherein the output is executed by one of a hard copy output apparatuses *comprising* a printer 22 (see col. 4, line 61).

Regarding claims 37 and 38, Shibaki et al. disclose wherein the output is executed by a soft-copy output apparatus *comprising* a liquid crystal display section 61 (see col. 6, line 56).

Regarding claims 52, 55, and 60, Shibaki et al. disclose data display means for displaying image-output instruction data and image data, and data processing means for analyzing the image

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output instruction data *comprising* display section 61 and display control unit 70 (see col. 7, lines 24-25).

Regarding claims 53 and 54, Shibaki et al. disclose wherein said data display means displays a summary of data for specifying an image to be output *comprising* a parameter section 67 for setting various parameters relating to the copy mode (see col. 6, lines 55-64).

Regarding claim 58, Shibaki et al. disclose data editing means for editing data of the information recording medium *comprising* read and write operation of the optical disk (see col. 6, lines 5-14).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shibaki et al.** '368 in view of **Kurihara et al.** '278.

Regarding claim 56, Shibaki et al. disclose all of the limitations with respect to claim 55. However, Shibaki et al. do not disclose an alarm display when the number of prints to be output is larger than the number of outputtable prints. Kurihara et al. disclose an alarm displayed when


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memory data overflow signal is detected (see col. 3, lines 7-14 and 45-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to display an alarm when the memory is full and cannot obtain any data or prints to be outputted.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato et al. '824, Tahara et al. '211, Nagata '957, Miura '307, and Nakamura et al. '134 are cited to further show the state of the art with respect to an image forming apparatus with means of storing image data on a diskette.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick Fields whose telephone number is (703) 305-0573.

  
EDWARD L. COLES  
SUPERVISORY PATENT EXAMINER  
GROUP 2700

df

March 25, 2000